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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/034,966  | 12/26/2001  | Antoine Kawam        | 00216-529001 / T-681     | 9312             |
| 26161   | 7590        | 02/12/2004           |                          |                  |
| FISH & RICHARDSON PC<br>225 FRANKLIN ST<br>BOSTON, MA 02110 |             |                      | EXAMINER<br>LAMM, MARINA |                  |
|   |             |                      | ART UNIT                 | PAPER NUMBER     |
|   |             |                      | 1616                     |                  |
| DATE MAILED: 02/12/2004                                     |             |                      |                          |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/034,966 | <b>Applicant(s)</b><br>KAWAM ET AL. |  |
|                              | <b>Examiner</b><br>Marina Lamm       | <b>Art Unit</b><br>1616             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15-20 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15-20 and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Acknowledgment is made of the amendment filed 11/17/03. Claims pending are 1-9, 11-13, 15-20 and 27-30. Claims 10, 14 and 21-26 have been cancelled. Claims 1, 17 and 27 have been amended.

#### *Claim Rejections - 35 USC § 102*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-9, 11, 12, 15-20 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Watson (US 3,858,764).

Watson teaches a pressurized container having a supplemental source of propellant (a reservoir) capable of releasing propellant into the system when the additional propellant is required. See col. 1, lines 38-45. Watson teaches that his containers can be used for dispensing products wherein the propellant is in a gaseous phase and/or dissolved in the composition (concentrate), thus being useful for dispensing both foams and non-foamed formulations such as liquids and solids. See col. 2, lines 65-67; col. 3, lines 1-15. In particular, the container of Watson can be used for dispensing shaving foams containing soap solutions. See col. 3, lines 58-61; Example 1. With respect to Claim 5, Watson teaches that when the composition is dispensed, the propellant from the reservoir is released and a gas/liquid equilibrium is established. See col. 4, lines 48-60. The reservoir is either solid or is enveloped in a solid material which is retained in the container as the composition is being dispensed. See col. 3, lines 20-25. The reservoir can be made of organic polymeric materials such as rubbers (e.g. silicones, latex rubbers, polyisobutylene rubbers, etc.), including partially vulcanized (cross-

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linked) rubbers which are capable of holding the propellant in solution which does not flow under its own weight. See col. 4, lines 38-45; col. 5, lines 55-60; col. 7, lines 49-59. Watson teaches that the reservoir material is capable of swelling when charged with the propellant (e.g. forms gel with the propellant) and returns to its original dimensions as it loses the propellant. See col. 9, lines 62-67; Table 4. Useful propellants include aliphatic hydrocarbons and halogenated hydrocarbons having vapor pressures in the range 5-200 psig. See col. 2, lines 55-60. When the compositions of Watson are dispersed as foams, a uniform density of foam is maintained until virtually the entire contents (about 90%) of the dispenser have been dispensed. See col. 20, lines 42-56. With respect to the limitation "a sorbant, comprising a foam or fibrous material," Watson exemplifies rubber foam as a suitable material for the reservoir. See Table 7. With respect to Claim 11, which recites that the solubility parameter of the polymer is within 2 units of the solubility parameter of the propellant, this limitation is inherent in the Watson reference because his polymers are capable of holding the propellant in solution (i.e. either gel or liquid) as discussed above. With respect to Claim 19, which recites that the sorbant has a relatively higher affinity for the propellant than for the composition, Watson teaches that his reservoir materials "should not absorb, dissolve or otherwise remove any component of the concentrate to an extent which would cause the dispensed concentrate product to be significantly changed in character". See col. 5, lines 8-14. With respect to Claim 20, which recites that the propellant is substantially insoluble in the composition, Watson teaches that his dispenser can be used for dispensing various systems, including those in which the propellant is a separate phase and not dissolved in the composition (e.g. aqueous concentrates and solid products). See col. 3, lines 1-8. With respect to Claims 27-30, which

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are directed to a method of manufacturing a personal care product, Watson teaches providing a polymer reservoir (sorbant) within a container containing a shaving foam, sealing the container and adding the propellant through the valve. See Example 1. The reservoir can be mounted on the dip tube or formed as a continuous coating on the inside wall of the container. See col. 4, lines 9-24.

Thus, Watson teaches each and every limitation of Claims 1-9, 11, 12, 15-20 and 27-30.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of de LaForcade et al. (US 6,464,111) and Villars (US 5,451,396).

Watson applied as above. Watson teaches that his containers are suitable for dispensing a variety of compositions such as aqueous concentrates, toothpastes, shaving foams, solids and hairsprays. See col. 3, lines 1-8; col. 20, lines 59-69. Watson does not explicitly teach dispensing compositions comprising a gel as claimed in the instant claim. However, it is known in the art of cosmetic products to formulate shaving products as either gels, foams or creams and package them in pressurized dispensing containers. See de LaForcade et al. at col. 4, lines 51-54. Further, Villars teaches that clear products such as gels, are becoming increasingly more desirable to the consumers because they are perceived as less irritating. See col. 1, lines 24-30. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the products of Watson such that to use

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shaving gels as dispensing compositions. One having ordinary skill in the art would have been motivated to do this to obtain an additional, conveniently dispensed, consumer-appealing shaving product as suggested by de LaForcade et al. and Villars.

***Response to Arguments***

5. Applicant's arguments filed 11/17/03 have been fully considered but they are not persuasive.

6. In response to the Applicant's argument that Watson does not teach or fairly suggest that his reservoir includes foam, it is noted that rubber foam reservoir is exemplified in Table 7 at col. 17-18.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on M-F from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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2/6/04



SHELLEY A. DODSON  
PRIMARY EXAMINER